

IV. REMARKS

Applicant has considered the current Office Action with mailing date of March 22, 2007. Claims 1 - 17 are pending in this application. By this amendment, claims 1, 4, 6, 8, 10, 13, 14 and 17 have been amended. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Office. The present claim amendments and cancellations are only for facilitating expeditious prosecution of the allowable subject matter noted by the Office. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant respectfully reserves the right to pursue the full scope of the subject matter of these original claims and other claims in one or more subsequent patent application that claim(s) priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 2, 3, 6 - 9, 11 - 12 and 15 - 16 are objected as being indefinite for claiming a trademark. Claims 4, 6, 8, 13 and 17 are rejected as allegedly being indefinite under 35 U.S.C. §112, ¶2. Claims 10 - 17 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 6 - 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Beadle et al. (US Pat. No. 6,766,373), hereinafter "Beadle". Claims 1 - 5 and 9 - 17 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Applicant's Admitted Prior Art (APPA) in view of Beadle and Tyrell, III (US Pat. No. 7,062,527), hereinafter "Tyrell". Applicant submits the following arguments in support of current amendments in the claims for the Office's consideration.

A. AMENDMENT TO SPECIFICATION

Applicant submits that ¶[0001] – ¶[0004], ¶[0006], ¶[0009], ¶[0015], ¶[0017] – ¶[0020] and ¶[0024] – ¶[0026] of the specification have been amended to replace the term “Java” with “**JAVA™**”. Applicant also included in ¶[0001] the phrase ““(“JAVA” is a trademark of Sun Microsystems, Inc., Santa Clara, CA.)”” to prevent the use of the term in any manner that would diminish its validity as a trademark. As a result, Applicants respectfully request withdrawal of the objection to the specification.

B. OBJECTION TO CLAIMS 2, 3, 6 – 9, 11 – 12 and 15 – 16

With respect to the Office’s rejection of claims 2, 3, 6 – 9, 11 – 12 and 15 – 16, Applicant submit that the claims have been amended such that the term “Java” is replaced with “**JAVA**”. Applicant submit the current amendment clearly indicates that the claims are directed to methods, systems and program products that are applied in relation with JAVA resources but do not directed to claiming such resources. In view that the claims are directed to the environment (i.e. web application and/or server) in which JAVA resources are utilized/incorporated, the Applicant submits it is not the JAVA resources that is claimed. As such, Applicant submit that the current amendment better define the claims, which points out and distinctly claims the subject matter which applicant regards as the invention. Accordingly, Applicant respectfully requests that the Office withdraw this rejection.

C. REJECTION OF CLAIMS 4, 6, 8, 13 and 17 UNDER 35 U.S.C. §112, ¶2

With regard to the rejection of claim 6, under 35 U.S.C. §112, ¶2 as allegedly being indefinite, Applicant has amended the claim which now recites, *inter alia*, "...wherein the adding is performed through a separate web application having a duty to serve JAVA™ resources." By adding resources through a separate web application, no disruption would occur in a current session in the primary web application to which resources is added and hence on going session information will not be lost.

With regard to the rejection of claim 4, 8, 13 and 17 under 35 U.S.C. §112, ¶2 as allegedly being indefinite, Applicant has amended the claims to address the antecedent basis issue by replacing the phrase "the group" with "a group".

Applicants believe that these amendments in the respective claims better define the subject matter that Applicant considers as the invention. Accordingly, Applicant respectfully request that the Office withdraw the rejections.

D. REJECTION OF CLAIMS 10 – 17 UNDER 35 U.S.C. §101

The Office rejected claims 10 – 13 as allegedly being directed to non-statutory subject matter because the claims apparently recites a software without claiming associated hardware. Applicants submit that currently amended independent claim 10 recites, *inter alia*, "A system implemented in a computer for dynamically adding resources...". The amendment sets forth a software as part of a computer through which some form of physical transformation occurs when the software system is implemented. As such, currently amended claim 10 is directed to software system that is associated with hardware. Consequently, dependent claims 11 – 13 also recite

additional features in association with hardware. Accordingly, Applicants submit that the claimed system is directed to statutory subject matter under 35 U.S.C §101.

With respect to the Office's rejection of claims 14 – 17 as allegedly being directed to non-statutory subject matter because the claims directly or indirectly covers a form of energy, Applicants respectfully submit that the claims are directed to statutory subject matter because each of the claims recites the use of a tangible medium or hardware for implementing the computer program product.

Applicants have amended independent claim 14, which currently recites, *inter alia*, “[a] program product stored on a computer readable medium for dynamically adding resources in a web application server ... executed by a computer...”. Applicants believe that currently amended claim 14 recites a product of manufacture because a computer software or program product embodied in a tangible medium (e.g., a computer readable medium) is a product of manufacture capable of setting forth a process. Such a program product involves some form of physical transformation within the computer for generating adding and or updating resources in a web application server without disrupting an ongoing session. MPEP§2106 IV B.2(b). To this extent, the result of such a program product is one that is useful in a practical application within the technological arts. As such, Applicants respectfully request that the Office withdraw this rejection and allow the currently amended claim 14.

As to the Office's interpretation that any transmission medium includes a carrier signal, Applicants submit that it is the computer program product/software, not the carrier signal that is executed by the computer. The execution of the computer program product by the computer forms a structural and functional interrelationship therebetween for “...dynamically adding

resources in a web application server...”, claim 14. Applicants submit that the recited computer program product embodied in a carrier signal is tangibly embodied in a manner so as to be executable by the recited computer. As such, the claimed computer program product so embodied sets forth a product of manufacture that is capable of causing functional change through hardware components in the computer.

Furthermore, Applicants submit the carrier signal is a product produced by a machine (e.g., computing device). In the *Chakrabarty* opinion, the Supreme Court has stated that, “...the term ‘manufacture’ in § 101 in accordance with its dictionary definition to mean ‘the production of articles for use from raw materials prepared by giving to these materials new forms, qualities, properties, or combinations whether by hand labor or by machinery.’” MPEP §2105. As such, the program product embodied in a carrier signal is manufactured by a computer for the portability of the program product.

In addition, the claimed carrier signal embodies a software including structured data which, when received or implemented in a computer, defines structural and functional inter-relationships with the computer. Whether the computer software is embodied in the form of a tangible recordable medium (e.g., storing the software on a CD-ROM) or the form of a carrier signal (e.g., transmitting the software over a wired or wireless network), both are but different forms of computer readable medium primarily to enable the transfer of a software and its implementation in a computer to cause functional changes therein. As such,

[t]here is no reason to treat works that are distributed... by means of transmission differently than works distributed... by other, more conventional means. Copies distributed via transmission are as tangible as any distributed over the counter or through the mail. Through each method of distribution, the consumer receives a tangible copy of the work.

Statement of Bruce A. Lehman, Assistant Secretary of Commerce and Commissioner of Patents and Trademarks, on S. 1284 and H.R. 2441 before the Subcommittee on Courts and Intellectual Property Committee on the Judiciary, United States House of Representatives, and the Committee on the Judiciary, United States Senate, November 15, 1995. Although this statement is directed at issues relating to infringement of copyrighted works, Applicant submits that the rationale applies equally with respect to infringement of patented works, such as computer software.

Further, since publication of the Guidelines and issuance of the Office Action, the United States Supreme Court commented on the patentability of electronic transmissions in *Microsoft Corp. v. AT&T Corp.*, Slip Op. No. 05-1056 (April 30, 2007). The case concerned “computer software first sent from the United States to a foreign manufacturer on a master disk, or by electronic transmission...” *Microsoft*, Slip Op., p. 1. Initially, the Court addressed when software qualifies as a “component” under 35 U.S.C. § 271(f). The Court stated that software must be combinable, i.e., “expressed as a computer-readable ‘copy’”. *Microsoft*, Slip Op., p. 9. With this requirement, the Court held that “a copy of [computer software] qualifies as a ‘component’ under § 271(f).” *Microsoft*, Slip Op., p. 12. Throughout the decision, the Court used two specific examples of copies of computer software that were at issue in the case, i.e., software embodied on a master disk, e.g., CD-ROM, and software embodied in an electronic transmission. *Microsoft*, Slip Op., p. 1. To this extent, Applicant submits that the Court held that software embodied in an electronic transmission may qualify as a ‘component’ under § 271(f).

As such, Applicant submits that the Court implicitly held that software embodied in an electronic transmission comprises patentable subject matter under 35 U.S.C. § 101. In particular, at least one previous case held that the scope of 35 U.S.C. § 271(f) is commensurate with the scope of 35 U.S.C. § 101. The Federal Circuit has held that “every form of invention eligible for patenting falls within the protection of section 271(f).” *Eolas Technologies Inc. v. Microsoft Corp.*, 399 F.3d 1325, 73 U.S.P.Q.2D (BNA) 1782 (Fed. Cir. 2005). Applicant submits that the converse logically follows. That is, everything protectable under 35 U.S.C. § 271(f) is eligible for patenting under 35 U.S.C. § 101. Were this not the case, an inventor would be able to prevent another from exporting his/her invention outside of the United States under § 271(f), but would not be able to prevent another from making or using the invention in the United States.

In light of the above stated reasons, Applicant respectfully submits that claims 14 – 17 clearly comprise statutory subject matter under 35 U.S.C. § 101 and requests withdrawal of the rejection thereof. However, should the Office maintain this rejection, Applicant respectfully requests that the Office provide specific support (i.e., controlling law) for its position that the claimed invention does not comprise statutory subject matter.

E. REJECTION OF CLAIMS 1 – 5, 6 – 8, 9 – 17 UNDER 35 U.S.C. §103(a)

With regard to the Office’s 35 U.S.C. §103(a) rejection of claims 1 – 5, 6 – 8 and 9 – 17 as allegedly being unpatentable over the primary reference, AAPA, in view of Beadle and Tyrell, III, Applicants asserts that the Office’s §103(a) rejection is flawed. Specifically, the Office cited ¶[0004] under “Summary of the Invention” and ¶[0021] in the “Detailed Description of the Invention” as the AAPA. According to MPEP §2129, discussion of any reference in the

specification or during prosecution, the use of Jepson claims, references submitted in the Information Disclosure Statement would be deemed as Applicant's Admission of Prior Art. However, the Office's specific citation of ¶[0004] and ¶[0021] in the specification did not disclose or discuss any references. On the contrary, the cited paragraphs disclose aspects/embodiments of the claimed invention. To this extent, Applicant is unable to appreciate the Office's rejection based on the Applicant's disclosure. Applicant would like to remind the Office that "[t]he primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art", MPEP §706.03, and not whether an application is patentable over itself. Applicant seeks Office's clarification as to how the Office arrived at deeming the disclosure of the application as prior art against itself. It appears that the Office has not only applied impermissible hindsight in the examination of this application but also exercised the practice of hindsight on the basis of the application and not on pertinent prior art.

With respect to the secondary references, Beadle and Tyrell, Applicants submit that Beadle and Tyrell do not teach each and every feature of the claimed invention. The Office cited col. 2, line 39 – 47 in Beadle as teaching "a system that would allow users to switch over to other connections without losing session information". Page 5 of Current Office Action. However, col. 3, lines 6 – 10 in Beadle specifically teaches "re-routing ... of session from the first connection route to the second..." and not "adding the resource to each requesting web application...", claim 1. To this extent, Beadle's method is not equivalent to the claimed invention. As such, Applicant respectfully requests that the Office withdraw the rejection based on Beadle. In view that Beadle does not teach the claimed invention, Applicant has not provided further arguments with respect to Tyrell for brevity. Since the Office is unable to find pertinent

references as prior art that teaches the claimed features, the Office has not established a prima facie case of obviousness. As such, Applicant respectfully request that the Office withdraw this rejection and allow the claims.

V. CONCLUSION

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

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